

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicants: HEEN, Olivier, et al.

Examiner: SIDDIQI, Mohammad A.

Serial No: 10/589,655

Group Art Unit: 2493

Filed: August 16, 2006

Docket: PF040026

For: METHOD FOR INSERTING A NEW DEVICE IN A COMMUNITY OF
DEVICES

Mail Stop Appeal Brief-Patents

Hon. Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

APPEAL BRIEF

Applicants appeal the status of Claims 5-12 as rejected in the final Office Action dated December 23, 2010, pursuant to the Notice of Appeal filed April 20, 2011 and submit this appeal brief. Please charge fee for the Appeal Brief, and a one month extension to our deposit account 07-0832.

TABLE OF CONTENTS:

1.	Real Party in Interest	page 3
2.	Related Appeals and Interferences	page 3
3.	Status of Claims	page 3
4.	Status of Amendments	page 3
5.	Summary of Claimed Subject Matter	page 4
6.	Grounds of Rejection to be Reviewed on Appeal	page 6
7.	Argument	page 7
8.	CLAIMS APPENDIX	page 17
9.	RELATED EVIDENCE APPENDIX	page 19
10.	RELATED PROCEEDINGS APPENDIX	page 20

1. Real Party in Interest

The real party in interest is THOMSON LICENSING, the assignee of the entire right title and interest in and to the subject application by virtue of an assignment recorded with the Patent Office on August 16, 2006 at reel/frame 018213/0912.

2. Related Appeals and Interferences

Appellant is not aware of any appeals or interferences related to the present application.

3. Status of Claims

Claims 5-12 are pending. Claims 1 – 4 have been cancelled. Claims 5 and 9 are independent. Claims 5-12 stand rejected and are under appeal.

A copy of the Claims 5-12 is presented in Section 8 below.

4. Status of Amendments

A response to a Final Office Action, dated December 23, 2010, was filed and entered on March 10, 2011. No responses/amendments were filed subsequent to the March 10, 2011 response. The claims listed in section 8 “Claims Appendix” of this Appeal Brief correspond to the claims submitted in Appellant’s response on March 10, 2011.

5. Summary of Claimed Subject Matter¹

The claimed invention, as recited in claim 5, is directed to a method for inserting a new device in a community of devices comprising: selecting, by a user, a user chosen device from one of the community of devices for authorizing insertion of a new device into the community (page 4, lines 23 – 30 and Fig. 4); storing, by each device of the community which receives an insertion request from a new device, the insertion request in a memory of said each device (page 4, lines 22 – 23, page 7, lines 8 – 9, and Figs. 4-5); forwarding, by each device of the community which receives a request from the user chosen device, the at least one stored insertion request to said user chosen device (page 7, lines 13-23, and Figs. 4-5); and performing, by the user chosen device, at least one user action for authorizing the insertion of the new device into the community (page 8, line 22 – page 9 line 13).

The claimed invention, as recited in claim 9, is direct to a device adapted to belong to a community of networked devices, wherein said device comprises: a first memory for storing at least one insertion request received from a new device requesting to be inserted in the community (page 5, lines 29 – 33 and Fig. 7); a network interface for sending the at least one insertion request stored in said first memory upon request from a device chosen by a user of the community for performing at least one user action for authorizing the insertion of the new device in the community (page 5, lines 34 – 38 and Fig. 7); a second memory for storing insertion requests sent by other devices of the community when said device is the

1 It should be explicitly noted that it is not the Appellant's intention that the currently claimed or described embodiments be limited to operation within the illustrative embodiments described below beyond what is required by the claim language. Further description of the illustrative embodiments are provided indicating portions of the claims which cover the illustrative embodiments merely for compliance with requirements of this appeal without intending to read any further interpreted limitations into the claims as presented.

user chosen device (page 6, lines 3 – 7 and Fig. 7).

6. Grounds of Rejection to be Reviewed on Appeal

Claims 5-12 are rejected under 35 U.S.C. § 102(b) as being anticipated by Eiden et al. (6,829,487) (hereinafter “Eiden”).

The preceding rejections under 35 U.S.C. § 102(b) are presented for review in this Appeal with respect to Claims 5–12, as argued with respect to independent Claims 5 and 9.

Regarding the grouping of the claims with respect to the rejections under 35 U.S.C. §102(b), Claims 5 – 8 stand or fall with Claim 5 due to their respective dependencies therefrom. Claims 9 - 12 stand or fall with claim 9 due to their respective dependencies therefrom.

7. Argument

A. CLAIMS 5-12 ARE NOT ANTICIPATED UNDER 35 U.S.C. § 102(B) BY EIDEN.

Anticipation under 35 USC § 102 requires the disclosure in a single prior art reference of each element of the claim under consideration. *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F. 2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, arranged as in the claim.” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)). “The *identical invention* must be shown in as complete detail as is contained in the ...claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP § 2131 (emphasis added).

Appellant submits that for the reasons discussed below the Examiner has not properly established a *prima facie* case of anticipation.

Eiden pertains to a communication group of wireless devices communicating in a radio network (col. 2, lines 18 – 21). An applicant device applies for membership into the communication group from each group member (col. 2, lines 22 – 25). Each member of the communication group replies to the applicant as to whether or not that member accepts the applicant’s admission into the communication group (col. 2, lines 25 – 28). After all group members have replied to the applicant, the applicant will receive information on whether or not his membership request has been accepted (col. 2, lines 27 – 29).

By contrast, the claimed invention provides for a user to select one particular device,

referred to as the user chosen device, as the device to authorize entry of new devices into the community. Any device in the community can receive requests from applicants to join the community. Devices receiving such requests will then forward the requests to the user chosen device. The user chosen device authorizes the applicant's insertion into the community.

For example, assume a home network has a gateway connected to a personal computer (PC). The gateway and the PC are devices within a community of devices (i.e., home network). The PC is connected to the gateway through a wired connection. The PC does not have any wireless connection. A laptop is connected to the gateway through a wireless connection. A user selects the PC as the user chosen device to authorize new devices into the community. The laptop requests insertion into the community to the gateway. The gateway forwards the insertion request to the PC. The PC authorizes the insertion request which is forwarded to the laptop through the gateway. According to the claimed invention the PC, which is the user chosen device, receives the forwarded request and ultimately approves the laptop's insertion request.

By contrast, in Eiden, under a similar scenario, the laptop must request membership into the home network by making a request to the gateway and the PC. Since the PC does not have a wireless connection, there would be no way that the PC could receive the laptop's request for membership. Clearly, this operation differs from that of the claimed invention.

In Eiden, even if the laptop could communicate directly with the PC, both the gateway and the PC would then have to decide independently whether or not to allow the laptop to join the community. The laptop would then be notified of the collective decision. Again, this differs from the claimed invention since according to the claimed invention only

the user chosen device, here the PC, authorizes the insertions into the community.

The Examiner on page 5 of the Final Office Action dated December 23, 2010 (“Final Office Action”) and on page 2 of the Advisory Action dated March 22, 2011 (“Advisory Action”) indicates that “it is noted that the features upon which application relies (i.e., “A laptop is connected to the gateway through a wireless connection. A user selects the PC as the user chosen device to authorize new devices into the community. The laptop requests insertion into the community to the gateway. The gateway forwards the insertion request to the PC.”...) are not recited in the rejected claim (s). Applicants’ response to the Final Office Action included claim 5 annotated to show where in claim 5 the features of the above example are found. The annotated claim 5 is recited below:

5. A method for inserting a new device (**laptop**) in a community of devices (**gateway, PC**) comprising:

selecting, by a user, a user chosen device (**PC**) from one of the community of devices (**gateway, PC**) for authorizing insertion of a new device (**the laptop**) into the community; (**A user selects the PC as the user chosen device to authorize new devices into the community.**)

storing, by each device of the community which receives an insertion request from a new device, (**An insertion request from a new device - The laptop requests insertion into the community to the gateway.**) the insertion request in a memory of said each device (**The PC stores the insertion request from the laptop in a memory**);

forwarding, by each device of the community which receives a

request from the user chosen device, the at least one stored insertion request to said user chosen device (**The gateway forwards the insertion request to the PC**); and

performing, by the user chosen device (**the PC**), at least one user action for authorizing the insertion of the new device into the community (**A user at the PC authorizes the insertion request which is forwarded to the laptop through the gateway.**).

The aforementioned annotated claim clearly shows how the illustrated example is recited in claim 5. However, these features are not taught or suggested in Eiden as explained below.

Referring to Figures 3A – 3D of Eiden and col. 7, line 21 – col. 8, line 58, there is shown an exemplary illustration of how the application process of Eiden operates. A, B, C, and D are members of a group in which E wishes to join. The group has decided that it takes a vote of at least 75% of the members for E to join. In Fig. 3a, E is within range of members A and C. E sends an apply message to A (reference line 307) and A votes not to accept E and sends his decision back to E (reference line 308). In the reply message back from A, E receives information on the other members of the group, including that E is within range of C. E then sends an apply message to C (reference line 309), C votes to accept E and sends back to E a response indicating C's acceptance of E (reference line 310). E now knows that he needs acceptance from others in the group to reach the 75% threshold. (See col. 7, line 46 – col. 8, line 15).

In Fig. 3b, E is within range of members B and D and outside of the range of

members A and C. E sends an apply message to B (reference line 312) and an apply message to D (reference line (reference line 314). B votes to accept E and responds back to E (reference line 313). D votes to accept E and responds back to E (reference line 315). E now knows that E has obtained 75% of the votes from the members and is now a member. (See col. 8, lines 16 – 31).

In Fig. 3c, E is within range of B and D. E informs B that he is a member of the community by sending a message to B that seeks information on the other members of the group (reference line 316). B sends the information to E (reference line 317). Additionally, E informs D that he is a member of the community by sending a message to D (reference line 318). (See col. 8, lines 32 – 51).

In Fig. 3d, E is within range of A and C. E informs A and C that he is a member of the community by sending a message to A (reference line 320) and a message to C (reference line 319).

Eiden does not teach or suggest the **user chosen device** as recited in claim 5 which states “selecting, by a user, a user chosen device from one of the community of devices for authorizing insertion of a new device into the community”; “forwarding, by each device of the community **which receives a request from the user chosen device**, the at least one stored insertion request to said user chosen device”; and “**performing, by the user chosen device**, at least one user action for authorizing the insertion of the new device into the community” (emphasis added).

The Examiner on page 2 of the Final Office Action indicates that Eiden in Fig. 2 and col. 5, lines 1-33 recites the feature of “selecting, by a user, a user chosen device from

one of the community of devices for authorizing insertion of a new device into the community.”

Eiden, col. 5, lines 3 – 13, states:

This can be done in such a manner, for instance, that the applicant creates by means of a communication application of his communication device an apply message and transmits said apply message by his communication device to a member of the group, preferably to all the group members that are within the range of the communication device to a member of the group, preferably to all the group members that are within the range of the communication device of the applicant. The apply message can be transmitted to each group member separately in a separate message or alternatively as one message to all the group members that are within the range of the communication device of the applicant.

The Examiner misapplies the notion of a device accepting an apply message with the notion of selecting a chosen device. The above cited section of Eiden merely indicates that an applicant can send an apply message to any or all devices of the group. However, the device in Eiden that accepts an apply message does not perform the actions of the user chosen device which are recited in the claimed invention. In particular, the device in Eiden that accepts an apply message does not request, from all the other devices in the community, that the device accepting an apply message forward the message to a user chosen device (i.e., “forwarding, by each device of the community which receives a request from the user chosen device, the at least one stored insertion request to said user

chosen device”)

The Examiner cites Eiden, col. 6, lines 22 – 58 as reciting the forwarding step of claim 5. This cited section of Eiden states:

Fig. 2 shows a flow chart of a method according to an embodiment of the invention for selecting a potential member to a group by a member of said group. The group member receives a message (step 201) that can, for instance, be a membership request from a person applying for membership (reference 202), a voting result deciding on the selection of the applicant from the applicant or another group member (reference 208), for instance, or a request for information from an accepted new member (reference 212). The membership request is preferably received by a communication application implemented for receiving said membership request. Other alternative embodiments enabling the reception of a membership request can also be used. Such embodiments include reception as a voice message or short message. Step 202 is a check to see if said message is a membership request from a potential member wanting to join the group, or some other message. If it is a membership request, the group member forms a decision in step 203 on whether the applicant is suitable to be a member of the group on the basis of the information, for instance, that the group member received in the membership request message. If the member considers the applicant suitable to be a member of the group, the member votes for the membership of the applicant and

transmits his reply as feedback information to the applicant (step 204) and stores the received information of the applicant in his communication device, for instance in a database register, such as a group information matrix, (step 205) and marks the applicant as a potential member (step 206). If in step 203, the member is of the opinion that the applicant is not suitable to be a member, the member votes against the membership of the applicant and transmits his reply as feedback information to the applicant (step 207). In this case, too, the group member stores the received information of the applicant in his communication device, for instance in the group information matrix mentioned earlier, (step 205) and marks the applicant as a potential member (step 206).

Nowhere in the above cited section does Eiden teach or suggest that the device receiving a membership request request from all other devices in the community forward to the user chosen device, membership requests that they may have received. Clearly, the forwarding step of claim 5 is not taught or suggested in Eiden.

The Examiner on page 7 of the Final Office Action contends that the “performing, by the user chosen device, at least one user action for authorizing the insertion of the new device into the community” is disclosed in Eiden in the above cited section, col. 6, lines 22-58. The Examiner misapplies the fact that any device in Eiden can accept a membership request with the feature of the user chosen device of the claimed invention. The fact that any device can accept membership differs from the user chosen device of claim 5, that only authorize the insertion of the new device into the community.

Furthermore, the user chosen device, recited in claim 5, performs all the above-mentioned functions indicated in the selecting, forwarding, and performing steps which are not taught or suggested in Eiden.

Accordingly, Eiden does not teach or suggest the user chosen device recited in claim 5. As such, claim 5 and its dependent claims are not anticipated by Eiden.

Remaining independent claim 9, and the claims that depend therefrom, recite the above-discussed features of claim 5, and, thus, are also not anticipated by Eiden.

In view of the above, Applicants respectfully request the withdrawal of the rejection to these claims.

G. CONCLUSION

At least the above-identified limitations of the pending claims are not disclosed or suggested by the teachings of the cited references. Accordingly, it is respectfully requested that the Board reverse the rejections of Claims 5–12 under 35 U.S.C. § 102(b).

Please charge the amount of \$540.00, covering fee associated with the filing of the Appeal Brief, to **Thomson Licensing Inc., Deposit Account No. 07-0832**. In the event of any non-payment or improper payment of a required fee, the Commissioner is authorized to charge **Deposit Account No. 07-0832** as required to correct the error.

Respectfully submitted,

BY: /Paul P. Kiel/
Paul Kiel, Attorney for Applicant
Registration No.: 40,677
Telephone No.: 609/734-6815

Date: 6/21/11

Thomson Licensing LLC
Patent Operations
P.O. Box 5312
Princeton, NJ 08543-5312

8. CLAIMS APPENDIX

1 - 4. Canceled.

5. (Previously Presented) A method for inserting a new device in a community of devices comprising:

selecting, by a user, a user chosen device from one of the community of devices for authorizing insertion of a new device into the community;

storing, by each device of the community which receives an insertion request from a new device, the insertion request in a memory of said each device;

forwarding, by each device of the community which receives a request from the user chosen device, the at least one stored insertion request to said user chosen device; and

performing, by the user chosen device, at least one user action for authorizing the insertion of the new device into the community.

6. (Previously Presented) The method according to claim 5, further comprising:

selecting, using the user interface of the user chosen device, one of the insertion requests received by the user chosen device, to authorize the device having emitted said insertion request to be inserted in the community.

7. (Previously Presented) The method according to claim 6, further comprising:

sending, from said user chosen device, an insertion request to the new device inserted in the community to request that said user chosen device enters the new device's community.

8. (Previously Presented) The method according to claim 7, wherein said insertion request from said user chosen device is transmitted to the new device inserted in the community through the device of the community having first forwarded the insertion request from the new device to the user chosen device in case said user chosen device cannot directly communicate with the new device.

9. (Previously Presented) A device adapted to belong to a community of networked devices, wherein said device comprises:

- a first memory for storing at least one insertion request received from a new device requesting to be inserted in the community;

- a network interface for sending the at least one insertion request stored in said first memory upon request from a device chosen by a user of the community for performing at least one user action for authorizing the insertion of the new device in the community;

- a second memory for storing insertion requests sent by other devices of the community when said device is the user chosen device.

10. (Previously Presented) The device according to claim 9, further comprising:

- a user interface allowing a user to select one of the insertion requests received by the user chosen device, to authorize the device having emitted said insertion request to be inserted in the community when said device is the user chosen device.

11. (Previously Presented) The method of claim 5, wherein insertion requests contain a provable identity of the new device.

12. (Previously Presented) The method of claim 11, wherein the device having received an insertion request from a new device is further able to broadcast the provable identity of the chosen device to the new device.

9. **RELATED EVIDENCE APPENDIX**

None.

10. RELATED PROCEEDINGS APPENDIX

None